

1 REMARKS

2 In the present Office Action, the Examiner rejected claims 1-18, 21 and 22, all claims
3 currently pending in the subject patent application, under 35 U.S.C. § 103(a) as being unpatentable in
4 light of various combinations of prior art patents. In response, submits arguments in opposition to the
5 Examiner's rejection of claims due to obviousness and in support of the patentability of those claims.
6 As set forth in more detail below, the Applicants believe the arguments and amendments made in
7 response to the Examiner's rejections have placed the application in condition for allowance.

8 With regard to the obviousness rejections for Applicant's patent application, Section
9 103(a) only denies patentability to those inventions whose "subject matter as a whole would have been
10 obvious at the time the invention was made to a person having ordinary skill in the art to which said
11 subject matter pertains." (35 U.S.C. § 103.) The teachings from the prior art utilized to determine
12 obviousness must be reasonably pertinent to the problems solved by Applicant's invention. (See In re
13 Clay, 23 USPQ2d 1058, 1060 (CAFC 1992).) If the subject matter and purpose of Applicant's
14 invention are different from the subject and purpose of the invention described in a prior art reference,
15 it would be improper to utilize that reference in the obviousness analysis as a person skilled in the art
16 would not have been motivated to look to or consider such a reference in attempting to solve the
17 problems solved by Applicant's invention. (See In re Clay, 23 USPQ2d at 1061.) Under such
18 circumstances, a person having ordinary skill in the art would not apply the teachings of the prior art
19 to arrive at Applicant's invention. (Id.)

20 Even if certain prior art references are considered analogous art, there must be
21 something in these references that suggests combining their teachings in order to reject claims under
22 the obviousness standard. As stated by the court in In re Geiger, 2 USPQ2d 1276 (CAFC 1987),
23 "[o]bviousness cannot be established by combining the teachings of the prior art to produce the
24 claimed invention, absent some teaching, suggestion or incentive supporting the combination." (In re
25 Geiger, 2 USPQ2d at 1278.) The motivation or suggestion to combine references must exist,
26 otherwise the determination of obviousness involves nothing more "than indiscriminately combining

prior art." (Micro Chemical Inc. v. Great Plains Chemical Co., 41 USPQ2d 1238, 1244 (CAFC 1997).) In In re Fritch, 23 USPQ2d 1780 (CAFC 1992), the Federal Circuit stated the following:

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so. Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. (In re Fritch, 23 USPQ2d at 1783-84 (internal quotes and citations removed).)

The above principles are applied to the Examiner's rejections of the various claims set forth in the Office Action. As set forth below, it is Applicant's position that the currently pending claims are not obvious in light of the prior art.

Claims 1, 6, 8, 9, 12 and 17

The Examiner rejected claims 1, 2, 6, 8, 9, 12 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Lemelson (U.S. Patent No. 3,933,311) in view of Beladakis (U.S. Patent No. 5,715,628). With regard to claim 1, the Examiner takes the position that Lemelson discloses a landscape edging system having a core with two longitudinal channels disposed therein and a connector having a channel shaped sleeve portion with an internal body member having several extending portions thereon that are each configured to be received in one of the core's longitudinal channels and that Beladakis discloses a landscape edging with a core having a relatively thin shell layer. Based on the above, the Examiner takes the position that it would have been obvious to modify

1 the edging system of Lemelson by adding a plastic coating as disclosed by Beladakis so as to provide
2 UV protection so as to have the edging last longer. Respectfully, Applicant disagrees with the
3 Examiner's analysis with regard to the obviousness of combining Lemelson with Beladakis.

4 With regard to the modification of Lemelson edging system by adding the plastic
5 coating of Beladakis, Applicant respectfully believes the Examiner is mistaken and that it would not
6 have been obvious at the time of Applicant's invention to add the protective or ornamental covering
7 for landscaping dividers of Beladakis to the edging system of Lemelson to obtain Applicant's
8 invention. The covering of Beladakis is configured to be placed over the exposed exterior of the
9 upper section of a landscape divider. The interior of the cap is configured to conform to the exterior
10 shape of the landscape divider over which it will be placed. The cap is made of flexible plastic that
11 effectively "snaps" over the divider to change the appearance of the landscape divider or repair a
12 damaged section of the landscaped divider. The landscape "fence structure" of Lemelson is not
13 adaptable for coating with another material and no mention or suggestion is present in Lemelson to
14 coat the fence structure with another material. Lemelson is directed to an assembly of a plurality of
15 lattice-like units 11 having a central portion 12 with a sheet-like wall 13 having openings 14 therein.
16 To coat the fence structure would be to lose the lattice-like effect of the Lemelson invention. No
17 reference, discussion or even suggestion is made to place a relatively thin shell layer around the
18 lattice-like units and it could not be done without substantial difficulty in maintaining the openings 14
19 in wall 13. The brief mention of making the central portion out of metal is made without any
20 reference to needing to coat the metal to prevent corrosion, leading to the conclusion that only a
21 corrosion resistant metal would be suitable for the fence structure of Lemelson. To suggest otherwise
22 appears to require an application of hindsight to obtain a coated, lattice-like structure that provides the
23 benefits set forth in Lemelson with the cap of Beladakis, which is improper for the obviousness
24 analysis. (See In re Fritch, 23 USPQ2d at 1783-84.)

25 With regard to the edging strip of the present patent application, the teachings of
26 Beladakis are not reasonably pertinent to the problems solved by Applicant's invention. (See In re

1 Clay, 23 USPQ2d at 1060.) Because the subject matter and purpose of Applicant's invention are
2 substantially different from the subject and purpose of the invention described in Beladakis, it is
3 improper to utilize these patents in the obviousness analysis because a person skilled in the art would
4 not have been motivated to look to or consider them in attempting to solve the problems solved by
5 Applicant's invention. (See Id. at 1061.) Even if this patent is considered pertinent to Applicant's
6 invention, neither Lemelson nor Beladakis are concerned with, discuss or are in any way related to
7 providing an edging strip having an inner core layer substantially encapsulated by a thin shell layer.
8 As such, nothing suggests or compels combining the teachings of Lemelson or Beladakis, in any
9 combination suggested by the Examiner, to arrive at Applicants' invention. As stated by the court in
10 In re Geiger, "[o]bviousness cannot be established by combining the teachings of the prior art to
11 produce the claimed invention, absent some teaching, suggestion or incentive supporting the
12 combination." (In re Geiger, 2 USPQ2d at 1278.) The motivation or suggestion to combine the
13 references must exist, otherwise the determination of obviousness involves nothing more "than
14 indiscriminately combining prior art." (Micro Chemical, 41 USPQ2d at 1244; In re Fritch, 23
15 USPQ2d at 1783-84.) Respectfully, nothing in the Lemelson or Beladakis references or any
16 knowledge generally available to one of ordinary skill in the art compels, teaches, suggests or even
17 offers any incentive such that an individual wanting to invent a dual layer edging strip with internal
18 channels disposed in the inner layer such as Applicant's would utilize the references as suggested by
19 the Examiner. (See In re Fritch, 23 USPQ2d at 1783; In re Geiger, 2 USPQ2d at 1278.

20 With regard to the connector portion of Applicant's landscape edging system, Applicant
21 disagrees with the Examiner that Lemelson discloses a connector having a sleeve portion with an
22 internal body member having several extending portions thereon that are configured to be received in
23 the channels of the edging strip. Specifically, the sleeve portion, allegedly shown as 25, 26, 22, 27
24 and 28 of Fig. 1, is not a sleeve as that term is used in Applicant's invention and neither the internal
25 body member (22) nor the extending portions (26A, 26B, 28A and 28B of Figs 1 and 2) are internal to
26 the sleeve portion. Instead, as clearly shown in the figures, item 22 is a central shank or tubular

1 formation that is not internal to the "sleeve" and the extending portions are also not internal to the
2 identified "sleeve" portion. In fact, neither the central shank nor the extending portions are internal to
3 any part of the connector or coupling member in Lemelson. Figure 2 is an end view of the lattice-like
4 units or, in Applicant's terms, the edging strip portion of the system. With regard to Applicant's
5 invention, the sleeve portion, which is described beginning at page 19, line 14 and best shown in
6 Figure 3, is a generally channel-shaped member having open ends 44 and 46 configured to receive an
7 end of the edging strip therein such that the sleeve portion covers the ends of two adjoining edging
8 strips. Applicant previously amended claim 1 to specifically identify the sleeve portion as being
9 channel-shaped and having open first and second ends that are configured to receive an end of the
10 edging strip therein and to specifically identify the internal body member as being disposed in the
11 sleeve portion. Applicant believes the amended language sufficiently clarifies his invention, as set
12 forth in claim 1, and distinguishes from the prior art referenced by the Examiner.

13 With regard to the dependent claims which depend from claim 1, these claims are
14 believed to be allowable based on the believed allowability of claim 1

15 With regard to independent claim 12, Applicant previously amended claim 12 to
16 include the amendment with regard to claim 1 and to specifically identify the core layer as being
17 substantially encapsulated by the thin shell layer. Applicant's arguments with regard to the
18 obviousness of claims 1 and 2 in light of Lemelson and Beladakis, as well as with regard to Gruber
19 below, are also applicable to claim 12 and, therefore, are incorporated herein with respect to claim 12.
20 With regard to the dependent claims which depend from claim 12, these claims are believed to be
21 allowable based on the believed allowability of claim 12 in light of the arguments and amendments set
22 forth herein.

23
24 Claims 2 and 21

25 The Examiner rejected claims 2 and 21 under 35 U.S.C. § 103(a) as being unpatentable
26 over Lemelson in view of Beladakis in view of Gruber (DE 3,039971 A). Applicant respectfully

disagrees with the Examiner's analysis with regard to claims 2 and 21. Specifically, Applicant disagrees that it would have been obvious to further modify the invention of Lemelson, as modified by Beladakis, by utilizing co-extrusion to substantially encapsulate the core layer as allegedly suggested by Gruber. Gruber discloses a panel used for forming a landscape boundary that can be made of "rigid or elastic plastics, or metal, which may have a plastic coating". Applicant believes that the proper interpretation of the Gruber patent is that because the panel is configured to be placed in the ground where corrosion of metals will be a problem, the panel can be made of plastic, which is substantially corrosion resistant, or made out of metal with the metal having a plastic coating to prevent corrosion of the metal. For this purpose, there would be no need to coat the plastic with another plastic and coating the metal with plastic is not the same as co-extruding an encapsulated core material. As clearly set forth in Applicant's disclosure, the preferred method of making Applicant's edging strip having a shell layer encapsulating the core layer is to co-extrude the core layer and the shell layer such that they form a substantially unitary component. As discussed above, there is no reason or reasonable ability to co-extrude Lemelson with the "covering" referenced in Beladakis. With regard to the plastic coating mentioned at page 3, line 16 of the translation of Gruber, there is no suggestion of co-extruding the metal with the plastic coating (plastic coated metals be well known in various types of art). Applicant previously amended claim 2 to clarify that the core layer and shell layer are co-extruded in a manner such that the shell layer substantially encapsulates the core layer.

Claims 3-5 and 13-15

The Examiner rejects claims 3-5 and 13-15 as being unpatentable over Lemelson in view of Beladakis in further view of Walsh et al. (U.S. Patent No. 4,820,469), in that Walsh describes the use of re-grind plastic as a core material, the use of high quality plastic as a shell and the combination of the two for a plastic component such as Applicant's edging strip. Initially, Applicant's arguments with regard to the obviousness of claims 1 and 12 in light of Lemelson and Beladakis are also applicable to claims 3-5 and 13-15 and, therefore, are incorporated herein with respect to claims

3-5 and 13-15. In addition, because claims 3-5 depend from amended claim 1 and claims 13-15 depend from amended claim 12, these claims are believed to be allowable based on the believed allowability of claims 1 and 12, respectively, in light of the arguments and amendments set forth above. In addition, with regard to the use of re-grind or recycled materials for the core layer, high quality plastic for an thin shell layer and the combination of the two for an edging strip, such use is not referenced, discussed or suggested by anything in either Lemelson or Beladakis and, as such, it would not be obvious to one skilled in the art to apply the teachings of Walsh to Lemelson and Beladakis to obtain Applicant's invention. (See In re Geiger, 2 USPQ2d at 1278.) To suggest otherwise appears to require an application of hindsight to obtain a coated, lattice-like structure that provides the benefits set forth in Lemelson with the cap of Beladakis and a re-grind or recycled material core of Walsh, which is improper for the obviousness analysis. (See In re Fritch, 23 USPQ2d at 1783-84.) In addition, Walsh is not directly related to landscape edging systems and, to Applicant's knowledge, use of co-extrusion to substantially encapsulate a core layer made out of re-grind or recycled materials with a higher quality outer shell layer has never been utilized for a landscape edging strip or divider.

Claims 7 and 16

The Examiner rejected claims 7 and 16 as being unpatentable over Lemelson in view of Beladakis in further view of Wuster (U.S. Patent No. 6,389,742) in that the limitations of claims 1 and 12, the base independent claims, are obvious as set forth above and that Wuster discloses a connector having extending portions that are tapered. Applicant's arguments with regard to the obviousness of claims 1 and 12 in light of Lemelson and Beladakis are also applicable to claims 7 and 16 and, therefore, are incorporated herein with respect to claims 7 and 16. In addition, because claim 7 depends from claim 1 and claim 16 depends from claim 12 (as claims 1 and 12 were previously amended), these claims are believed to be allowable based on the believed allowability of claims 1 and 12, respectively, in light of the arguments and amendments set forth above.

1 Claims 10, 11 and 18

2 The Examiner rejected claims 10, 11 and 18 as being unpatentable over Lemelson in
3 view of Beladakis in further view of Danna, et al. (U.S. Patent No. 6,108,969) in that the limitations
4 of claims 1 and 12, the base independent claims, are obvious as set forth above and that Danna
5 discloses a stake member configured to engage the edging strip to the ground. Applicant's arguments
6 with regard to the obviousness of claims 1 and 12 in light of Lemelson and Beladakis are also
7 applicable to claims 7 and 16 and, therefore, are incorporated herein with respect to claims 7 and 16.
8 In addition, because claim 7 depends from claim 1 and claim 16 depends from claim 12, these claims
9 are believed to be allowable based on the believed allowability of claims 1 and 12, respectively (as
10 claims 1 and 12 were previously amended), in light of the arguments and amendments set forth above.

11 With regard to claim 11, Applicant disagrees with the Examiner with regard to Figure 6 of Danna
12 showing a stake penetrating the side of an edging strip. Danna shows the stake through the top of the
13 edging strip, not the side of the edging strip as shown in Figure 4 and discussed at page 23, lines 6-13
14 of Applicant's disclosure

15
16 Claim 22

17 The Examiner rejected claim 22 under 35 U.S.C. § 103(a) as being unpatentable over
18 Lemelson in view of Beladakis in view of Gruber, as to claim 1, and further in view of Walsh.
19 Applicant respectfully disagrees with the Examiner's analysis with regard to claim 22, which depends
20 from claim 21, and incorporates the arguments set forth above with regard to claims 1, 2, 12 and 21
21 (claim 21 being similar to claim 12 with the additional limitations of the shell layer being integrally
22 formed around the core layer and the extending portions of the internal body member being configured
23 to be securely received in the channels of the edging strip). In addition, with regard to the use of re-
24 grind or recycled materials for the core layer, high quality plastic for a thin shell layer and the
25 combination of the two for an edging strip, such use is not referenced, discussed or suggested by
26 anything in either Lemelson, Beladakis or Gruber and, as such, it would not be obvious to one skilled

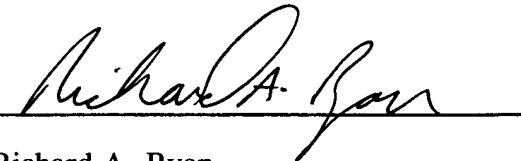
1 in the art to apply the teachings of Walsh to Lemelson, Beladakis or Gruber to obtain Applicant's
2 invention. (See In re Geiger, 2 USPQ2d at 1278.) Further, Walsh is not directly related to landscape
3 edging systems and, to Applicant's knowledge, use of co-extrusion to substantially encapsulate a core
4 layer made out of re-grind or recycled materials with a higher quality outer shell layer has never been
5 utilized for a landscape edging strip or divider. In addition, claim 22 depends from claim 21 and,
6 therefore, is believed to be allowable as being dependent from an allowable base claim.

7 In light of the arguments and amendments set forth above, Applicant respectfully
8 requests the Examiner to withdraw the rejection of claims 1-18, 21 and 22 set forth in the office action
9 and to allow such claims. No claims are added or cancelled, therefore, no additional fees for claims
10 are believed due.

11 In view of the foregoing, it is submitted that this application is in condition for
12 allowance. Reconsideration of the rejections and objections in light of this Amendment is requested.
13 Allowance of Claims 1-18 and 21-22 is respectfully solicited.

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15 Respectfully Submitted,

16
17 By 

18 Richard A. Ryan
19 Reg. No. 39,014

20 Ryan & Engnath
21 8497 N. Millbrook, Suite 110
22 Fresno, CA 93720

23 Phone: (559) 447-1837
24 Fax: (559) 447-1042
25 e-mail: richard@fresnopatentlaw.com
26